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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/802,161	03/08/2001	Christopher Keith	0505-4007	1139
24259	7590	06/14/2005	EXAMINER	
BRENDA POMERANCE LAW OFFICE OF BRENDA POMERANCE 260 WEST 52 STREET SUITE 27B NEW YORK, NY 10019			GRAHAM, CLEMENT B	
			ART UNIT	PAPER NUMBER
			3628	

DATE MAILED: 06/14/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

**Office Action Summary**

Application No.

09/802,161

Applicant(s)

KEITH, CHRISTOPHER

Examiner

Clement B. Graham

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1) ☒ Responsive to communication(s) filed on 08 March 2001.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4) ☒ Claim(s) 1-30 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-30 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date 9/17/2001.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

DETAILED ACTION  
Claim Rejections - 35 USC § 101

1. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-30, are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The basis of this rejection is set forth in a two prong test of:

- (1) whether the invention is within the technological arts; and
- (2) whether the invention produces a useful, concrete and tangible result.

For a claimed invention to be statutory, the claimed invention must be within the technological arts. Mere ideas in the abstract (i.e., abstract idea, law of nature, natural phenomena) that do not apply, involve, use or advance the technological arts fail to promote the "progress of science and the useful arts" (i.e., the physical sciences as opposed to social sciences, for example) are found to be non-statutory subject matter. For a process claim to pass muster, the recited process must somehow apply, involve, use, or advance the technological arts. In the present case, claims 1-30, do not recite any structure or functionality to suggest that a computer performs the recited claims. Thus, claims 1-30 are rejected as being directed to non-statutory subject matter.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

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3. Claims 1-30, are rejected under 35 U.S.C. 102(e) as being anticipated by Potter et al (Hereinafter Potter U.S Patent 5, 787, 402).

As per claim 1, Potter discloses a method of operating at least two markets, comprising: automatically representing an order in a first market and a second market, and automatically ensuring the order is executable in at most one of the first and second markets.(Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 2, Potter discloses wherein each of the first and second markets operates according to a two phase action protocol, and the automatically ensuring includes obtaining permission to act from a controlling process.(see column 3 lines 13-45 and column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 3, Potter discloses wherein the permission is an affirmation to act upon a specified number of shares of the order. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 4, Potter discloses wherein the controlling process is a trading process.(see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 5, Potter discloses wherein the controlling process is a market process.(see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 6, Potter discloses wherein one of the markets is in fast symbol mode, and the automatically ensuring includes canceling the order from the fast symbol market before executing in the other of the markets .(see column 3 lines 13-45 and column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 7, Potter discloses wherein the automatically ensuring includes determining whether the order is in process at another market. .(see column 3 lines 13-45 and column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 8, Potter discloses wherein the order includes an order tail indicating the markets in which it is represented.(Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 9, Potter discloses wherein a platform process maintains a market file indicating the markets in which an order is represented, and wherein

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the automatically ensuring includes checking the market file. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 10, Potter discloses a method of representing an order in at least two markets, comprising: automatically sending the order to at least two markets, and automatically ensuring that execution authority for the order is in a single point. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 11, Potter discloses wherein the single point is a trading process. see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 12, Potter discloses wherein the order is associated with information indicating where execution authority for the order resides. (see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 13, Potter discloses wherein the associated information indicates whether any market at which the order is represented is in process, and the single point is the in process market. (see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 14, Potter discloses wherein the associated information is used to determine whether a process can declare itself to be the single point. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 15, Potter discloses a method of representing an order in at least two markets, comprising: automatically affirming availability of shares of the order to one of the at least two markets, and automatically receiving a pairing report from the one market for at least one of the affirmed shares. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 16, Potter discloses further comprising automatically canceling the paired shares from another of the at least two markets. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 17, Potter discloses further comprising placing an instruction to cancel at least one of the paired shares in a queue when the other market

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indicated that the at least one paired share was in process at the other market. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 18, Potter discloses further comprising checking availability of the shares before automatically affirming. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 19, Potter discloses wherein the checking availability is based on a number of unpaired shares of the order and a number of in process shares of the order. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 20, Potter discloses further comprising marking shares as in process after affirming their availability. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 21, Potter discloses wherein the shares are marked as in process for the market to which the shares were affirmed, and further comprising summing the in process shares at all of the markets at which the order is represented to obtain an in process number of shares. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 22, Potter discloses a method of executing an order in a market, comprising: automatically receiving the order from a source, automatically determining whether the market has authority to execute the order, and automatically executing the order after the market has determined that it has authority to execute the order. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 23, Potter discloses wherein the determining includes affirming availability of the order with the source. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 24, Potter discloses wherein the determining includes checking whether another market has authority to execute the order based on information associated with the order.

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As per claim 25, Potter discloses wherein the checking includes examining an order tail. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 26, Potter discloses wherein the checking includes examining a central order file. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 27, Potter discloses wherein automatically determining includes canceling the order from other markets at which it is represented. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 28, Potter discloses a method of canceling an order from a market, comprising: receiving an instruction to cancel shares of the order at the market, checking whether the shares are in process, and responding to the instruction to cancel in accordance with the result of the checking. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 29, Potter discloses wherein the responding includes returning a quantity of shares that are in process to a source of the instruction to cancel. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

As per claim 30, Potter discloses further comprising enqueueing an instruction to cancel in process shares. (Note abstract and see column 4 lines 45-67 and column 5-8 lines 5-67).

#### Conclusion

4. The prior art of record and not relied upon is considered pertinent to Applicants disclosure.

LUPIEN (US 5,101, 353) teaches automated system for providing liquidity to securities markets.

.Balasubramaniam et al (US Patent 6, 359, 633) teaches apparatus and method for abstracting markup language.


(US Patent 5,412, 804) teaches extending the semantics of the outer join operator for un-nesting queries to a data base.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Clement B Graham whose telephone number is 703-305-1874. The examiner can normally be reached on 7am to 5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Hyung S. Sough can be reached on 703-308-0505. The fax phone numbers for the organization where this application or proceeding is assigned are 703-305-0040 for regular communications and 703-305-0040 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.

  
**FRANZ PONIWŁ**  
**PRIMARY EXAMINER**

CG

June 11, 2005